

010079

REMARKS**1.) Claim Amendments**

Applicants have amended claims 1 and 13 to better claim the invention. Accordingly, claims 1-8, 11-18 and 21 are pending in the present patent application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 102

Claims 11 and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,077,791 issued to Salihi (hereinafter "Salihi"). To support such rejection, Salihi must disclose every element of the invention as claimed. More particularly, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). With the above requirement in mind, Applicant respectfully submits that Salihi fails to disclose every element of the invention as specified in each independent claim.

Regarding independent claim 11, the Applicants respectfully submit that Salihi as relied by the Examiner fails to disclose every limitation as specified in claim 11. More specifically, Salihi describes how an established call associated with a subscriber unit **gets inhibited or disconnected** if such subscriber unit detects there is a mode change in mid-conversation. If the call does get inhibited or disconnected, the subscriber unit would attempt to re-establish communication. *Column 5, line 56 to column 6, line 5 and Figure 4, reference numbers 412, 414, 416 & 418.* In contrast, the method of claim 1 is directed to how an established call in secure mode can be transitioned to clear mode. Such transition occurs while the call is in progress. See, e.g., *Patent Application, paragraphs [0018] & [0020]*. Thus, Salihi simply fails to disclose every limitation as

010079

specified in claim 11. Accordingly, claim 11 is not anticipated by and is patentably distinguishable over Salihi.

Regarding independent claim 21, it contains limitations that are similar to those of claim 11 and thus claim 21 is not anticipated by and patentably distinguishable over Salihi for reasons similar to those discussed above regarding claim 1.

3.) Claim Rejections – 35 U.S.C. § 103

Claims 1-3, 5, 12-15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,151,677 to Walter et al. (hereinafter "Walter") in further view of U.S. Patent No. 5,805,084 issued to Mannisto (hereinafter "Mannisto"). Before addressing this rejection in detail, it should be noted that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* 2142. To establish *prima facie* case of obviousness, certain criteria must be met. *First*, the prior art reference or references when combined must teach or suggest all the claim limitations. *Second*, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. With the above requirements in mind, Applicant respectfully traverses this rejection per discussion below.

Regarding independent claim 1, the Examiner relies on Walter to disclose a pushbutton that allows a user to activate a secure transmission mode for a secure module, admits Walter fails to disclose that the pushbutton must be pressed for a certain amount of time and relies on Mannisto to disclose how the pushbutton such as a key of a phone can be depressed and held for a given amount of time. *See Office Action, page 4*. If such key is depressed and held for a given amount of time, an established phone call would get terminated and the keyboard lock feature of the phone would get activated. If such key is depressed and held for less than the given amount of time, the established phone call would get terminated **without** the keyboard lock feature being activated. *Mannisto, column 2, lines 39-45*.

In general, the Walter, Mannisto or their combination fails to teach or suggest other call modes such as **secure-only**, **clear** and **auto secure modes** being specified

010079

in claim 1. In addition, Mannisto is directed to **how the phone should activate its keyboard lock feature after the call is terminated**. In contrast, the method of claim 1 is directed to **how a wireless handset should begin its operation associated with making a call**. More specifically, if the key is pressed and held for a time period greater than the predetermined amount of time, the wireless handset would enter a **secure mode unless** the handset is currently in either a secure-only mode or auto secure mode and if the key is pressed and held for a time period less than the predetermined amount of time, the wireless handset would stay in a **clear mode unless** the handset is currently in either a secure-only mode or auto secure mode. Walter, Mannisto or their combination simply fails to teach or suggest various modes associated with making a call and how a particular mode is activated based on [a] how long the key is pressed and held for and [b] what is the mode of the wireless handset before such key gets pressed and held.

Therefore, Walter, Mannisto or their combination fail to teach or suggest all the limitations of claim 1.

In addition, Applicants respectfully submit that there is no motivation or suggestion to modify Walter in light of Mannisto because Walter is generally directed to how to make a secure call while Mannisto is generally directed to how to activate the keyboard lock feature of a phone after the call is terminated. These fields of endeavor are different and thus, one skilled in the art would not find any motivation or suggestion to combine them.

Furthermore, even assuming *arguendo* that there is motivation or suggestion to combine the cited prior art references, their combination would still fail to teach or suggest the method of claim 1 since Walter and Mannisto fail to teach or suggest certain limitations of claim 1 as discussed above.

Accordingly, claim 1 should be non-obvious and patentably distinguishable over the cited prior art references.

Regarding claims 2-3, 5, 14-15 and 17, they directly or indirectly depend from independent claim 1, which is believed to be patentable, and thus these claims should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03*.

010079

Regarding claim 12, it contains limitations that are similar to those of claim 1 and thus claim 12 should also be non-obvious and patentably distinguishable over the cited prior art references for reasons similar to those discussed above regarding claim 1.

Claims 4 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable Walter and Mannisto in view of U.S. Patent No. 5,845,205 issued to Alanara et al. (hereinafter "Alanara"). These claims depend from independent claim 1, which is believed to be patentable, and thus these claims should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03*.

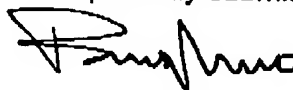
Claims 6-8 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable Walter and Mannisto as applied to claim 2 and further in view of U.S. Patent No. 6,442,406 issued to Harris et al. (hereinafter "Harris"). These claims indirectly depend from independent claim 1, which is believed to be patentable, and thus these claims should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03*.

010079

CONCLUSION

Claims 1-8, 11-18 and 21 are presently standing in this patent application. In view of the foregoing remarks, each and every point raised in the Office Action mailed on September 23, 2005, has been addressed on the basis of the above remarks. Applicant believe all of the claims currently pending in this patent application to be in a condition for allowance. Reconsideration and withdrawal of the rejections are respectfully requested. However, should the Examiner believe that direct contact with Applicants' attorney would advance the prosecution of the application, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,



by Dang M. Vo
Registration No. 45,183

QUALCOMM Incorporated
Attn: Patent Department
5775 Morehouse Drive
San Diego, California 92121-1714
Telephone: (858) 658-5787
Facsimile: (858) 658-2502